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REMARKS

Applicants have reviewed and considered the final Office Action mailed December 12, 2006. Claims 16-32 are currently pending.

In view of the following discussion, Applicants submit that none of the claims now pending in the application are obvious under provisions of 35 U.S.C. §103. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response including amendments.

Applicants respectfully request reconsideration and allowance of the claims in view of the following remarks.

Claims 16-21 and 24-32 are Patentable over Fries and Alexander under §103

Claims 16-21 and 24-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,317,885 to Fries ("Fries") in view of U.S. Patent No. 6,177,931 to Alexander et al. ("Alexander"). The rejection is traversed.

According to MPEP §2143, to establish a prima facie case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The combination of Fries and Alexander fails to establish a *prima facie* case of obviousness, because the combination fails to teach or suggest all the elements of the claimed invention. For example, the combination fails to teach or suggest the claimed

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option for storing the interactive advertisement on a user-defined storage device during presentation of the interactive advertisement.

Claim 16 recites, *inter alia*, "presenting the interactive advertisement, the interactive advertisement including a selectable option for the user to store the interactive advertisement on a user-defined storage device for future viewing during presentation of the interactive advertisement."

The Examiner concedes that Fries fails to teach the claimed option for storing an interactive advertisement on a user-defined storage device during presentation of the interactive advertisement. (See Office Action, page 4.) However, the Examiner alleges that Alexander bridges the substantial gap left by Fries.

Alexander fails to bridge the substantial gap left by Fries because Alexander fails to teach or suggest the claimed option for storing an interactive advertisement on a user-defined storage device during presentation of the interactive advertisement. By contrast, Alexander teaches using an ad window linked to a time and channel of an infomercial about the product or service in the ad window that will be telecast. (See Alexander, col. 4, ll. 34-42, emphasis added.) Alexander goes on to further teach that the user has an option to watch an infomercial or program the EPG to record the infomercial to the extent that one is scheduled for a future time. (See Alexander, col. 19, ll. 57-65; col. 27, ll. 60-64, emphasis added.) Notably, an option to store the currently presented ad window is not available. In otherwords, as previously argued, the claimed invention presents an option to store an interactive advertisement that is being presented, not one scheduled for a future time, as in Alexander.

To further illustrate the difference between Alexander and the Applicants invention, if an infomercial associated with the ad window is cancelled and no longer scheduled for a future time, the storing of the infomercial would never occur in Alexander's invention. As a result, recording of an infomercial associated with an ad window is uncertain. This is supported by the fact that Alexander clearly states "a viewer can instruct the EPG to record, or to add to the watch list, the infomercial or program, if there is one, that is associated with the advertisement. (See Alexander, col. 24, ll. 27-29, emphasis added.) In contrast, Applicants' invention advantageously provides a user an option for storing an interactive advertisement on a user-defined

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storage device during presentation of the interactive advertisement. Consequently, the Applicants' invention guarantees that the interactive advertisement will be stored for future viewing.

Notably, all the screenshots taught by Alexander only display options to "watch now" or "record". (See Alexander, FIGs. 8-10.) This is not the same as the ability to store an interactive advertisement on a user-defined storage device during presentation of the interactive advertisement. (See for example, Applicants' specification, FIG. 6.) Moreover, Alexander teaches the ability to record is not of the currently viewed advertisement, but rather a video clip (i.e. infomercial) associated with the displayed advertisement that will be broadcast at a future time. (See Alexander, col. 19, ll. 57-65; col. 20, ll. 1-3, emphasis added.) Consequently, the claimed invention provides more user-control and allows storage of any interactive advertisement being presented, not only ones scheduled for a future time.

In addition, the Examiner asserts that the previously added limitation of "during presentation of the interactive advertisement" is too broad because it does not distinguish if the storing portion or the future viewing portion is "during the presentation of the interactive advertisement". The Applicants respectfully submit that the only reasonable interpretation of the added limitation is that the storing is during the ° presentation of the interactive advertisement. The Applicants respectfully submit that "future viewing" of the presented advertisement "during presentation of the interactive advertisement" would make no grammatical or logical sense. Moreover, the Applicants' interpretation of the limitation is consistent with the arguments presented above.

Furthermore, *in arguendo*, even if Fries and Alexander were combined, the combination would still fail to teach or to suggest the Applicants' invention. The combination of Fries and Alexander would only teach the ability to record interactive commercials scheduled to be broadcasted at a future time. As a result, the combination of Fries and Alexander fails to teach or to suggest the Applicants' novel limitation of presenting the interactive advertisement, the interactive advertisement including a selectable option for the user to store the interactive advertisement on a user-defined storage device for future viewing during presentation of the interactive advertisement.

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Therefore, claim 16 is patentable over the combination of Fries and Alexander under §103.

Claims 17-26 depend, directly or indirectly, from claim 16 and, thus, inherit the patentable subject matter of claim 16, while adding additional elements and further defining elements. Therefore, claims 17-26 are also patentable over the combination of Fries and Alexander under §103 for at least the reasons given above with respect to claim 16.

Claim 27 recites, *inter alia*, "a user-defined storage device for storing the interactive advertisement, when the user selects an option to store the interactive advertisement for future viewing, during the presentation of the interactive advertisement." For the same reasons given above with respect to claim 16, claim 27 is patentable over the combination of Fries and Alexander under §103.

Claims 28-32 depend, directly or indirectly, from claim 27 and, thus, inherit the patentable subject matter of claim 27, while adding additional elements and further defining elements. Therefore, claims 28-32 are also patentable over the combination of Fries and Alexander under §103 for at least the reasons given above with respect to claim 27. Therefore, the rejection should be withdrawn.

Claims 22 and 23 are Patentable over Fries, Alexander, Lawler, and Matthews under §103

Claims 22 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fries in view of Alexander, in further view of U.S. Patent No. 5,699,107 to Lawler et al. ("Lawler"), and in further view of U.S. Patent No. 6,025,837 to Matthews ("Matthews"). The rejection is traversed.

For at least the reasons discussed above, the Fries and Alexander references fail to teach or suggest Applicants' invention as a whole, as recited in independent claim 16. Lawler and Matthews do not teach or suggest what is missing from Fries and Alexander as described above. Accordingly, any attempted combination of the Fries and Alexander references with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the

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independent claim. As such, Applicants submit that dependent claims 22 and 23 are also not obvious and are patentable under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

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CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and passage of the claims to allowance. If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

2/12/07

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